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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/654,939      | 12/22/2000  | Jae Moon Jo          | Q60198              | 7212             |

7590

03/04/2003

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EXAMINER

WERNER, BRIAN P

ART UNIT

PAPER NUMBER

2621

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/654,939

Applicant(s)

JO ET AL.

Examiner

Brian P. Werner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 6.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Priority Chain*

1. The preset application (i.e., 09/654,939) is a divisional reissue application filed on December 22, 2000, claiming priority to reissue application number 09/638,796 filed on August 11, 2000, which is a reissue application of number 08/495,591 filed on November 3, 1995, patent number 5,793,897, which is a 371 of international application number PCT/KR94/00177 filed on December 16, 1994, which claims priority to Korean applications 93-28074 and 94-34497, filed on December 16, 1993 and December 15, 1994 respectively.

### *Response to Amendments – Amendment Denied Entry*

2. Two preliminary amendments were filed. The first amendment, filed with the application, sought to amend the specification to include a reference to parent application number 09/638,796 and to cancel claims 1-11. The second amendment, filed on January 11, 2002, cancelled claims 4-7 and 12-17.

The aforementioned first preliminary amendment is defective and has been denied entry by the examiner. The amendment misidentifies the parent application serial number as "09/638,798" (it should have been "09/638,796"). In addition, the cancellation of claims 1-11 as called for by this amendment, in combination with the directions of the second preliminary amendment to cancel claims 4-7 and 12-17, results in the cancellation of all pending claims. However, it is clear from the record of the

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instant application, and from the record of the parent application 09/638,796, that the applicant intended to separate (during reissue prosecution) the patented claims directed to "encoding" and "decoding" into the two distinct applications (the instant application and its parent application respectively). The instant application, which is directed to "encoding", would accurately reflect the encoding claims if the changes of the second preliminary amendment were entered alone. The examiner's authority to deny entry of the first preliminary amendment as an administrative solution is derived from MPEP 714.19(G), and MPEP 714.23. The fact that applicant has apparently misidentified the parent application number, and has cancelled all pending claims as described above, leads the examiner to believe that the directions contained in the first amendment are defective.

The entry of the second preliminary amendment having been entered, claims 1-3 and 8-11 remain pending and are examined herein. The applicant's remarks contained in the second preliminary amendment corroborate this.

### ***Priority***

3. This application lacks the necessary reference to the prior application. A statement reading "This is a divisional of Reissue Application No. 09/638,796, filed August 11, 2000" or equivalent should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of all nonprovisional parent applications referenced should be included.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-3 and 8-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-7 and 12-17 of copending Application No. 9/638,796. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reason. The instant application lays claim to an encoding method, and application 09/638,796 lays claim to the corresponding decoding method. Both methods use the same, albeit reversed procedures to encode and decode image data respectively. One of ordinary skill in the art would find the encoding of the instant application to be obvious in view of the decoding claimed in 09/638,796, as the encoding is merely a reverse procedure of the decoding (and vice versa). A method of encoding is well within the skill level of one of ordinary skill in the art when presented with a method of decoding.

As further evidence that the encoding of the instant application is not patentably distinct from the decoding of 09/638,796, it is noted that both the encoding and decoding were claimed in the same issued patent prior to reissue proceedings (i.e., patent number 5,793,897). The examiner did not attempt to restrict the claims during prosecution.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. The examiner suggests and requests the early filing of a Terminal Disclaimer to expedite prosecution.

### ***Reissue Applications***

Claims 8-11 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

**Zigzag Scanning**

The use of “zigzag scanning” as the method of scanning orthogonal transform coefficients and as the method of selecting a variable-length coding table was argued by applicant during the prosecution of 08/495,591 as being essential to patentability.

Claims 8-11 do not recite “zigzag scanning”. Instead, claims 8-11 recite scanning “in a predetermined pattern” (e.g., claim 8, line 2) in the absence of zigzag scanning. However, the applicant surrendered the subject matter of “zigzag scanning” during the prosecution of 08/495,591. In the remarks filed with amendment B of serial number 08/495,591 (paper number 9; received on July 24, 1997), applicant argued the following points:

“The present invention improves on the prior art system” (page 4; bottom paragraph) where the prior art system uses “zigzag scanning” (page 3, bottom paragraph).

In an effort to distinguish the claimed invention over the prior art, the applicant argued:

“Keith does not teach or suggest making any type of selection based upon a zigzag scanning ...” (page 9, bottom paragraph).

Therefore, “zigzag scanning” was surrendered due to applicant’s arguments relating to patentability.

In addition, claims 8-11 do not recite “selecting” a variable length coding table according to a “zigzag scanning position”. Instead, claim 8 for example recites the selection of a variable length coding table according to “scanning position” (claim 8, line 6), in the absence of zigzag scanning position. In the remarks filed with amendment B

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of serial number 08/495,591 (paper number 9; received on July 24, 1997), applicant argued the following (refer to page 9 of applicant's remarks):

"Claims 3 and 7 depend respectively from claims 2 and 6 and further define the invention by requiring that the variable-length coding table is selected in accordance with the zigzag scanning position and quantization step size within the range determined by the corresponding mode."

Subsequently during the prosecution of 08/495,591, the examiner and applicant's representative agreed to combine the limitations of dependent claim 2 into independent claim 1 (refer to the interview summary, paper number 10), resulting in allowability. In amendment C of serial number 08/495,591 (paper number 11; received on September 2, 1997), applicant filed a claim amendment doing just that. The final, allowed version of claim 1 contained all of the limitations argued by applicant as cited above, thus surrendering the subject matter. Thus, the following subject matter was surrendered and cannot be recaptured:

( The selection of a variable-length coding table in accordance with the zigzag scanning position and quantization step size.

#### **Different Patterns for Regular and Escape Regions**

The setting and selecting of variable-length coding tables having different patterns for regular and escape regions of the orthogonal transform coefficients was argued by applicant during the prosecution of 08/495,591 as being essential to



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patentability and was added by amendment to the original claim to overcome the prior art.

Claim 8 does not recite the "setting" of a plurality of variable length coding tables "having different patterns of a regular region and an escape region". Instead, claim 8 merely recites the "setting a plurality of variable-length coding tables" (line 4) in the absence of any limitations defining different regions. The applicant surrendered this subject matter during the prosecution of 08/495,591. In the remarks filed with amendment B of serial number 08/495,591 (paper number 9; received on July 24, 1997), applicant argued the following:

"... This bit reduction is achieved in two ways. First, because the regular region and escape regions of each of the variable-length coding tables are different, the run, level pairs likely to have a high frequency of occurrence according to the specific quantization step size Qss and scanning position SP, can be assigned designations having a low number of bits. Secondly, the number of bits required to define the escape sequence ESQ can be reduced from the standard 21 bits" (*page 5, bottom paragraph; emphasis added by the examiner*);

and

"None of the sections of the reference cited by the examiner, nor any other sections of the reference, teaches or suggests setting a plurality of variable-length coding tables having **different patterns of a regular region and an escape region**" (*page 7, top paragraph, underlined emphasis added by applicant, bolded emphasis added by the examiner*).

Thus, the applicant argued that coding tables having different patterns for regular and escape regions resulted in the benefits of the claimed invention, and also served to

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distinguish over the prior art. Therefore, the following subject matter was surrendered and cannot be recaptured:

( setting a plurality of variable length coding tables having different patterns of a regular region and an escape region.

In addition, claim 8 does not recite, "wherein the selecting step has the selecting range of a plurality of variable-length coding tables having different patterns of a regular region and an escape region". Instead, claim 8 merely recites, "selecting one of said plurality of variable-length coding tables according to ..." (line 5) in the absence of the tables having different patterns of regular and escape regions. The applicant surrendered this subject matter during the prosecution of 08/495,591 for the reasons recited immediately above, and due to a claim amendment that resulted in allowability. That is, in amendment C of serial number 08/495,591 (paper number 11; received on September 2, 1997), the applicant filed a claim amendment adding the following subject matter to independent claim 1:

"wherein said selecting step has the selecting range of a plurality of variable-length coding tables having different patterns of a regular region and an escape region ..."

Therefore, the following subject matter was surrendered and cannot be recaptured:

( A selecting range of a plurality of variable-length coding tables having different patterns of a regular region and an escape region".

**Selecting According to Intra/Inter Mode of the Currently Processed Block**

The selecting of a variable-length coding table (i.e., having different patterns for regular and escape regions of the orthogonal transform as discussed above) according to the intra/inter mode information of a currently processed block was argued by applicant during the prosecution of 08/495,591 as being essential to patentability and was added by amendment to the original claim to overcome the prior art.

Claims 8-11 do not recite “selecting” a variable-length coding tables “according to the intra/inter mode information of the currently processed block”. Instead, claim 8 for example recites, “selecting one of said plurality of variable-length coding tables according to inter/intra mode information” (line 6) in the absence of “a currently processed block”. The applicant surrendered this subject matter during the prosecution of 08/495,591 due to a claim amendment that resulted in allowability. That is, in amendment C of serial number 08/495,591 (paper number 11; received on September 2, 1997), the applicant filed a claim amendment adding the following subject matter to independent claim 1:

“wherein said selecting step has the selecting range of a plurality of variable-length coding tables having different patterns of a regular region and an escape region according to said intra/inter mode information of the currently processed block” (*emphasis added by the examiner*).

Therefore, the following subject matter was surrendered and cannot be recaptured:

(  
Selecting a variable-length coding tables according to inter/intra mode information of a currently processed block.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Kato (US 5,559,557 A).

Regarding claim 8, Kato discloses an adaptive variable length coding method (e.g., figures 7 and 17) in which quantized orthogonal transform coefficients (i.e., “quantized DCT coefficients” at column 13, line 3; figure 17, numeral 700) are scanned in a predetermined pattern (i.e., “scan ... in a zigzag manner” at column 13, line 4), and are then variable length coded (i.e., “variable length code” at column 6, line 10) in a coding system for image data (“raw picture” at column 6, line 25), comprising the steps of:

setting a plurality of variable length coding tables (i.e., in figure 17, more than four tables are set; that is, block 704 has Huffman tables for DC and AC coefficients and block 707 has at least the three tables depicted in figures 9A – 9C; *NOTE however that*

*there are other ways the Kato reference anticipates this limitation; for example, table modifier 706 modifies the tables of 707 and thus sets a different set of tables; Kato states that "the ranges of the tables can be dynamically adapted to the encoding precision required" at column 4, line 49; in addition, Kato states that the "code tables ... are modified in accordance with results of statistical observation of input signals" at column 8, line 25; this is stated again by Kato at column 28, lines 41-55);*

selecting one of the plurality of variable length coding tables according to intra/inter mode information (e.g., in figure 17, block 709 sets switch to the "B" position for "intra" mode image information and "A" for inter mode image information; when the switch is in the "A" position, the Huffman tables of block 704 are utilized for coding; when the switch is in the "B" position, the coding tables of block 705 are utilized for coding), scanning position (e.g., block 703 [the DC/AC Separator] selects block 704 for AC coefficients and block 705 for DC coefficients; blocks 704 and 705 have different coding tables associated with them, and AC and DC coefficients have different positions in the scanning position) and quantization step size (i.e., "modifier 706 functions to control the storage 707, based on the intra\_dc\_precision code S26, to supply only a required portion of that table shown in FIG. 9A to the variable length encoder 705" at column 21, line 57; the precision code indicates the quantization step size as described at column 7, lines 32-40; the same table modification is made with respect to tables 9B and 9C as further described at column 22, lines 7+; thus, the coding tables are selected according to quantization step size), where the selecting step has the selecting range of

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a plurality of variable length coding tables (as stated above, a plurality of coding tables are available for selection); and

variable length coding said quantized orthogonal transform coefficients according to said selected variable length coding table (figure 17, the coded data is present at numeral 732).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kato (US 5,559,557 A) and Kaneko et al. (US 4,908,862 A).

Regarding claim 10, Kato selects the variable length coding table in accordance with said scanning position and quantization step size as described above, within the range determined in accordance with said intra/inter mode information (figure 17, numeral 709; "the ranges of the tables can be dynamically adapted to the encoding precision required for the portion of the video signal being encoded' at column 4, line 49; the encoding precision of the "intra" picture data is encoded with more precision than the inter picture data).

Regarding claims 9 and 10, Kato does not disclose the variable length coding tables as having different patterns of a regular and an escape region.

It is noted that "regular" and "escape" regions are described by applicant with respect to figure 4, where a regular region contains low frequency coefficients and an escape region contains high frequency coefficients. In the absence of any claimed elements further defining the nature of these regions, the examiner shall interpret regular and escape regions broadly in this manner.

Kaneko disclose a variable length image coding system (figure 10), comprising a plurality of variable length coding tables (figure 10, numeral 45) having different patterns of a regular and an escape region (as depicted in figure 12; there are five coding tables having different patterns of regular and escape regions; e.g., the first code set of figure 1 pertains to a regular regions and has the pattern of "1s" depicted in figure 12; the fifth code set of figure 10 pertains to an escape region and has the patter of "5s" depicted in figure 12; Kaneko states, "the distribution of the quantized signals for the low frequency components becomes dense in comparison with the distribution of the quantized signals for the high frequency components" at column 12, line 4, and "this means that the quantized signals for the low and the high frequency components are preferably encoded in accordance with different code sets" at column 12, line 12; thus, given that the patterns are different for the low and high frequency regular and escape regions respectively, the claimed limitations are met; *NOTE that the above limitations are also met by Kaneko by the embodiment of figure 13, where the first code set pertains to the regular regions and the second code set pertains to an escape region).*

It would have been obvious at the time the invention was made to one of ordinary skill in the art to modify the code sets (i.e., tables) of Kato, by providing different

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patterns for regular and escape regions as taught by Kaneko, in order to provide "high efficiency of encoding" where "the low and the high frequency components can be encoded into short length codes, respectively" (Kaneko, column 12, lines 8-12).

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kato (US 5,559,557 A) and Kaneko et al. (US 4,908,862 A) as applied to claim 9 above, and further in view of Jung (UK 2 267 410 A).

Regarding claim 11, the Kato and Kaneko combination does not teach the data of the escape region of said variable length coding table selected in said variable length coding step being "coded into data having variable run length and level length".

Jung disclose a variable length image coding system (figure 5), comprising coding the data of an escape region (figure 4) into data having variable run length and level length ("the escape sequence, which has coded data from the escape region, comprises an escape code ESC, run, level and sign data" at page 9, line 11; the run and level data are variable as described on page 8; i.e., see "value ranging from" and "level varies" at page 8, lines 10-11).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to code the data of the Kato and Kaneko combination escape region into data having variable run length and level length as taught by Jung, in order to reduce the number of bits, and thus provide maximum data compression, of the frequency coefficients in the "escape region" where the frequency of occurrence of data is low (i.e., page 8, bottom paragraph – page 9, top paragraph). That is, most if not all of the



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frequency coefficients in the escape region are zeros. Therefore, using the run, length codes reduces the amount of data required to represent these redundant coefficients by simply allocating them as a string of the same coefficients, rather than individually encoding the coefficients.

### ***Allowable Subject Matter***

11. Claims 1-3 are allowed. Each of these claim recite the variable length coding (VLC) of run, level data by selecting one of a plurality of VLC tables according to intra/inter mode information of a currently processed block, according to quantization step size, and according to zigzag scanning position, where the plurality of tables are set as having different patterns of an regular and escape regions according to statistical characteristics of the run, level data (e.g., as depicted in figures 6). These limitations in combination are neither anticipated nor obvious over the prior art.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Werner whose telephone number is 703-306-3037. The examiner can normally be reached on M-F, 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H. Boudreau can be reached on 703-305-4706. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

Brian Werner  
Patent Examiner  
February 24, 2003



**BRIAN WERNER  
PATENT EXAMINER  
ART UNIT 2621**

## Interview Summary

**Application No.**

09/654,939

**Applicant(s)**

JO ET AL.

**Examiner**

Brian P. Werner

**Art Unit**

2621

All participants (applicant, applicant's representative, PTO personnel):

(1) Brian P. Werner (Examiner). (3)\_\_\_\_\_.

(2) Alan Kasper (Applicant's Rep.). (4)\_\_\_\_\_.

Date of Interview: 19 February 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference  
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.  
If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: N/A.

Identification of prior art discussed: N/A.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The examiner and applicant's representative agreed that the first preliminary amendment was defective, and should not be entered (the defects are summarized in the first Office Action).

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.



Examiner's signature, if required

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

#### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.